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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

GERGISO, TECHANE

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2437

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,476	Applicant(s) DORSCH ET AL.	
	Examiner TECHANE J. GERGISO	Art Unit 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/30/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Final Office Action in response to the applicant's communication filed on October 30, 2008.
2. Claims 17-37 have been examined and are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 recites “A system for executing a least one software program”. Use of the word “System” does **not** inherently mean that the claim is directed to a **machine**. Only if at least one of the claimed elements of the system is **a physical part of a device** can the system as claimed constitute part of a device or a combination of devices to be a **machine** within the meaning of 101. Claim 17 is directed to comprise (a plurality of license key handler, and a license key handler manager), not a processes occurring as a result of executing the software program, a machine programmed to operate in accordance with the software program not a manufacturer structurally and functionally interconnected with the program in a manner which enables the software program to act as a computer component and realize its functionality. It is also clearly not directly to a composition of matter. [See applicant’s disclosure: 0036] “In a further advantageous

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refinement of the system, **the license key handler manager and the license key handler are integrated in one another in a software program.**” Therefore, claim 17 **may all be reasonably implemented as a software routines** and therefore claim 17 is rejected as **a system of software or program per se**, failing to fall within a statutory category of invention and rejected as non-statutory under 35 USC 101.

Response to Arguments

5. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

The applicant's response to overcome the Regarding the 35 USC 101 rejection is not persuasive. A "data link" is not necessarily a physical part of the system and in fact "a data link" is not defined in the specification as a physical part of the system not explicitly claimed as a physical hardware. For these reason the applicant's argument is not persuasive to overcome the 35 USC 101 rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 17-21, 23-25 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collier (US Pat No.: 7,299,209.) in view of Ishiguro et al (hereinafter referred to as Ishiguro, US Pub. No.: 2002/0194475 A1).

As per claim 17:

Collier discloses a system for executing at least one software program which needs to be enabled by a license key, the software program configured for open-loop or closed-loop control when executed by least one automation component, the system comprising:

a plurality of license key handlers of different types for receiving license keys of different types, respectively (column 1: lines 52-65; column 2: lines 1-15).

Collier does not explicitly disclose a license key handler manager connected by a data link to each license key handler to exchange data with each license key handler, said license key manager thereby providing one interface for a user for license enabling for software programs.

Ishiguro, in analogous art, however, discloses a license key handler manager connected by a data link to each license key handler to exchange data with each license key handler, said license key manager thereby providing one interface for a user for license enabling for software programs (0077; 0106; 0113). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Collier to include a license key handler manager connected by a data link to each license key handler to exchange data with each license key handler, said license key manager thereby providing one interface for a user for license enabling for software programs. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do

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so to further improve security of transmitted information by preventing an unauthorized user from posing as an authorized user using a desired piece of electronic equipment even if data required for encrypting or decrypting the information is stolen by the unauthorized user as suggested by Ishiguro in (0014).

As per claim 18:

Collier discloses a system, wherein the license key handler manager is configured to transfer the license key of one type to a license key handler of this same type (column 3: lines 30-40).

As per claim 19:

Collier discloses a system, wherein the plurality of license key handlers are associated with a license key memory, in which case the license key handler stores the license key in the license key memory (column 3: lines 30-40).

As per claim 20:

Collier discloses a system, wherein the license key handler manager is configured to identify the plurality of license key handlers by type (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54).

As per claim 21:

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Collier discloses a system, wherein the license key handler manager is configured to identify a license requirement related to the software program (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54).

As per claim 23:

Collier discloses a system, wherein the license key handler manager and the license key handler form one integrated software program (Figure 6: 242-266).

As per claim 24:

Collier discloses a system, wherein the system is an automation component having runtime software (figure 5: lines 52-64).

As per claim 25:

Collier discloses a method for enabling the execution of at least one software program which needs to be enabled by via a license key, the method comprising:

providing at least first and second license key handlers of different types for receiving a license key of different types, respectively (column 1: lines 52-65; column 2: lines 1-15);

identifying the type of license key handler of the at least first or second license key handler by the license key handler manager (column 3: lines 20-40).

Collier does not explicitly disclose connecting the first and second license handlers to a license key handler manager, said license key manager thereby providing one interface for a user

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for license enabling for software programs. Ishiguro, in analogous art, however, discloses connecting the first and second license handlers to a license key handler manager, said license key manager thereby providing one interface for a user for license enabling for software programs (0077; 0106; 0113). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Collier to include connecting the first and second license handlers to a license key handler manager, said license key manager thereby providing one interface for a user for license enabling for software programs. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to further improve security of transmitted information by preventing an unauthorized user from posing as an authorized user using a desired piece of electronic equipment even if data required for encrypting or decrypting the information is stolen by the unauthorized user as suggested by Ishiguro in (0014).

As per claim 31:

Collier discloses a method, wherein at least two software programs need to be enabled by at least first and second license keys of different types, further comprising transferring the first license key to the first license key handler, wherein the first license key and the first license key handler are of the same type (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54).

As per claim 32:

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Collier discloses a method, wherein the license key handler manager is executed on a personal computer (figure 3: server 301, client 302).

As per claim 33:

Collier discloses a method, wherein the first or second license key handler has a license key memory, and the license key handler manager transfers the license key to the license key memory (figure 3: server 301, client 302).

As per claim 34:

Collier discloses a method, wherein the first or second license handler has a license key memory, and the license key handler stores the license key in the license key memory or reads the license key from the license key memory (figure 3: server 301, client 302).

As per claim 35:

Ishiguro discloses a method, wherein the first and second license key handlers are configured to handle license keys of different types, and the license key handler manager identifies a type of the identified at least first or the second license key handler (0077; 0106; 0113).

As per claim 36:

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Ishiguro discloses a method, comprising adding software modules to the license key handler manager for updating the license key handler manager to communicate with a new type of license key handler (0083).

As per claim 37:

Collier discloses a method, wherein the license key handler manager is provided with the license key over the Internet (Figure 5: 505).

8. Claims 22, 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collier (US Pat No.: 7,299,209.) in view of Ishiguro et al (hereinafter referred to as Ishiguro, US Pub. No.: 2002/0194475 A1) and further in view of Frison et al. (hereinafter referred to as Frison, US Pat. No.: 6,049,789).

As per claim 22:

Collier discloses a distributed system having at least first and second automation components connected by a data link, the license key handler is configured to be executed on the first or second automation component, the software program is configured to be executed on the first automation components (column 1: lines 52-65; column 2: lines 1-15).

Collier and Ishiguro do not explicitly disclose the license key handler manager: is configured to be executed on the first or second automation component, and has a data connection to the license key handler. Frison, in analogous art, however, discloses the license key handler manager: is configured to be executed on the first or second automation component,

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and has a data connection to the license key handler (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Collier and Ishiguro to include the license key handler manager: is configured to be executed on the first or second automation component, and has a data connection to the license key handler. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a software pay-per-use (PPU) licensing system that includes one or more licensor license management systems (LMS) and one or more licensee LMS that operate to grant pay-per-use licenses for software applications as suggested by Frison in (0005).

As per claim 26:

Collier and Ishiguro do not explicitly disclose transferring the license key of one type to a license key memory of the identified first or second license key handler of this same type by the license key handler manager and retrieving the license key from the license key memory by the license key handler, wherein the execution of the soft-ware program is enabled by a check of the license key at the identified first or second license key handler using the software program. Frison, in analogous art, however, discloses transferring the license key to a license key memory of the identified first or second license key handler by the license key handler manager (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54); and retrieving the license key from the license key memory by the license key handler, wherein the execution of the soft-ware program is enabled by a check of the license key at the identified first or second license key

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handler using the software program (column 3: lines 30-40; figure 6: 242-266). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Collier and Ishiguro to include the license key handler manager: is configured to be executed on the first or second automation component, and has a data connection to the license key handler. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a software pay-per-use (PPU) licensing system that includes one or more licensor license management systems (LMS) and one or more licensee LMS that operate to grant pay-per-use licenses for software applications as suggested by Frison in (0005).

As per claim 27:

Frison discloses a system comprising:

transferring the license key to a license key server license key handler manager (column

1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54); and

transmitting the license key of one type to the identified first or second license key handler by the license key server, wherein the execution of the software program is enabled by a check of the license key at the identified first or second license key handler using the software program (column 3: lines 30-40; figure 6: 242-266).

As per claim 28:

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Collier discloses a method, wherein the license key is stored in and retrieved from a license key memory of the identified first or second license key handler (column 1: lines 46-60; column 2: lines 60-67; column 3: lines 45-54).

As per claim 29:

Frison discloses a method comprising:

transferring the license key to the license key handler by the license key handler manager (column 5: lines 1-15); and

storing the license key in a license key memory of the identified first or second key handler, wherein the execution of the software program is enabled by a check of the license key at the identified first or second license key handler using the software program (column 3: lines 55-67; column 4: lines 32-45).

As per claim 30:

Frison discloses a method, wherein the software program is executed in an embedded runtime system of an industrial automation or drive system having at least one automation component (column 5: lines 52-67).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior art.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Techane J. Gergiso/

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437